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08/714,964	09/17/96	HOCKERSON	A 59987-3/RE

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EXAMINER  
KAVANAUGH, J

ART UNIT  
3208

PAPER NUMBER

DATE MAILED: 07/28/97

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
**08/714,964**

Applicant(s)  
**Hockerson**

Examiner  
**Ted Kavanaugh**

Group Art Unit  
**3208**



☒ Responsive to communication(s) filed on Jun 24, 1997

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1, 2, and 4 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1, 2, and 4 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 2 and 4 is/are rejected under 35 U.S.C. 103(a) as being unpatentable over *WO 9111924 (Ellis '924)* in view of *US 9105491 (Ellis '491)*.

Ellis '924 discloses an athletic shoe comprising a midsole (midsole 127 in figure 7 or midsole 127 in figure 8 or the midsole as shown in figure 13, Ellis also refers to the midsole used in his prior applications) and an outsole, a lasting board (shank represents a lasting board, see page 23, lines 6-32; and/or see page 9, lines 4-13 which specifically recites a lasting board), a rigid heel counter (Ellis teaches that these slits/sipes can be applied to conventional shoes, and conventional shoes are well known to have rigid heel contours, see page 17, lines 31-33 and figure 1), a longitudinal channel (slits/sipes 151) in the midsole and outsole dividing the heel portion into a pair of laterally adjacent compression elements which are spaced apart an effective distance (see figure 3E and page 8, lines 3-6) substantially as claimed except for the channel extending through the peripheral rim. Ellis '924 on page 17, second paragraph does make reference to figures 13A-13D of the prior '509 application. The '509 application is US Appl. Serial No. 424509 which is

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WO 9105491 (Ellis '491). Ellis '491 discloses that the channels (sipes) can either extend through the peripheral rim (figure 13A) or not extend through the peripheral rim (figure 13B). Therefore it would have been obvious to one of ordinary skill in the art to provide the shoe of Ellis '924 as taught above with the channel extending through the peripheral rim, as taught by Ellis '491, to provide more flexibility to the shoe sole.

With regard to claim 2, Ellis '924 teaches that the slits/sipes (channels) 151 can vary in number beginning with one (see page 7, line 35-37) and that the slits/sipes can only be in the heel area (see page 17, lines 31-33). Therefore, it would appear to be an obvious design choice to have a longitudinal channel extend through only the heel portion of the sole as taught above, in view of Ellis '924, inasmuch as the channels would appear to be suitable in a number of different locations in the sole.

It is noted that one of the key elements of Ellis '924 "is the absence of either a conventional rigid heel counter or conventional rigid motion control devices, both of which significantly reduce flexibility in the frontal plane", page 9, lines 19-25. However, throughout the disclosure Ellis teaches that the slits/sipes (channels) can be applied to conventional shoes and/or existing shoes, for example: see page 8, lines 16-17; page 10, line 18 thru line 2 of page 11; and page 17, lines 31-33.

With regard to applicant's new limitation "said lasting board being devoid of penetrating channels", see page 23, lines 6-32 of Ellis '924. Ellis teaches that rigid devices (lasting boards) can be placed in the midsole or on top of it, such as conventional shoe shanks (lasting boards) and

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such rigid shanks must be penetrated fully by deformation sipes (channels). However, Ellis also teaches that the sipes (channels) don't have to penetrate the rigid shank (lasting board) to provide "a definite improvement over the same shoe sole without sipes; the improvement will simply be less than if the sipes did penetrate the shank fully", page 23, lines 17-19 of Ellis '924. Therefore, Ellis does teach shoe sole having a lasting board that is devoid of penetrating channels. Ellis teaches both, lasting boards with channels and ones without.

### *Response to Arguments*

3. Applicant's arguments filed June 27, 1997 have been fully considered but they are not persuasive.

Applicant argues that the rigid devices (shanks, lasting boards) in the soles of Ellis must be penetrated fully by deformation sipes so as to carry out the principal function of the deformation sipes which is to provide the otherwise rigid shoe sole with the capability of deforming easily.

To the contrary, Ellis teaches both. One's that have the rigid device be penetrated and ones that don't penetrate. Ellis teaches that the sipes (channels) don't have to penetrate the rigid shank (lasting board) to provide "a definite improvement over the same shoe sole without sipes; the improvement will simply be less than if the sipes did penetrate the shank fully", page 23, lines 17-19. Therefore, Ellis does teach shoe sole having a lasting board that is devoid of penetrating channels.

### *Conclusion*


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4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for response to this final action is set to expire **THREE MONTHS** from the date of this action. In the event a first response is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for response expire later than **SIX MONTHS** from the date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ted Kavanaugh whose telephone number is (703) 308-1244.

**Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1148.** Facsimile correspondence for this application should be sent to (703) 305-3579.

  
Ted Kavanaugh  
Primary Examiner  
Art Unit 3208

TK  
July 26, 1997